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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/065,063	09/13/2002	Karin Spalink	U01-0043(15)	2602

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EXAMINER

ABEL JALIL, NEVEEN

ART UNIT PAPER NUMBER

2165

DATE MAILED: 01/30/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/065,063

Applicant(s)

SPALINK ET AL

Examiner

Neveen Abel-Jalil

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on October 28, 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 and 16-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 5-8, 11-14, 16-21 and 23-26 is/are rejected.
- 7) ☒ Claim(s) 4, 9, 10, 22 and 27 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

Remarks

1. In response to Amendment filed on October-28-2005, claim 15 has been cancelled per applicant's request. Claims 1-14, and 16-27 are presently pending in the application.
2. Claim rejections under 35 USC § 101 and 35 USC § 112 have been overcome by applicant's amendment.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
4. Claim 19 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 19, lines 1, the recitation of "the predetermined signal" is indefinite. A broad limitation discloses in preceding claim 18 providing the optionality of selection of one occurrence, perhaps the limitation of "the predetermined signal". Now, in claim 19, a narrow selection limitation that falls within the broad limitation is disclosed and hence considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. See MPEP § 2173.05(c). The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required

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feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949).

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1-2, 5-7, 13-14, 16-21, and 25-26 are rejected under 35 U.S.C. 102(e) as being anticipated by Manning (U.S. Patent No. 6,963,640 B1).

As to claim 1, Manning discloses a method of search-by-number, comprising:

determining in a device whether a digit or wildcard has been entered in the device by a user for each entry until a first digit is entered by the user (See column 6, lines 4-14);

searching any numbers stored in the device to form a match list including any stored numbers matching a sequence of digits and wildcards entered by the user in response to the user entering the first digit (See column 8, lines 1-15, also see column 6, lines 28-46);

determining in the device whether another digit or another wildcard has been entered in the device by the user for each additional entry until another digit is entered by the user in

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response to the user not selecting any numbers in the a previous match list (See column 8, lines 1-15); and

searching the previous match list to form a new match list including any numbers matching a current sequence of digits and wildcards entered by the user in response to at least entry by the user being a digit (See column 3, lines 1-23).

As to claim 2, Manning discloses comprising displaying each match list (See column 5, lines 22-26).

As to claim 5, Manning discloses comprising displaying the match list in a predetermined order (See column 5, lines 51-53).

As to claim 6, Manning discloses comprising displaying the match list in an order corresponding to a position of the sequence of digits and wildcards in any stored numbers (See column 6, lines 39-46).

As to claim 7, Manning discloses comprising displaying the new match list in response to the new match list being formed (See column 7, lines 27-36, a new list is different from original list).

As to claim 13, Manning discloses a method of searching-by-number, comprising: receiving in a device a first entry by a user (See column 8, lines 1-4);

receiving an additional entry, if the first entry is a wildcard (See column 8, lines 1-15);
repeating receiving an additional entry until a digit is received (See column 3, lines 1-23);
searching any stored numbers to form a match list including any of the stored numbers with a digit in a first position and higher order positions in a sequence of digits forming each stored number (See column 5, lines 12-40, wherein “highest order” reads on starting the search by first digit entered and having certain priority rules stored in the database); and
searching the match list for numbers matching a sequence of entered digits and wildcards in response to receiving each additional entry that is a digit (See column 8, lines 1-15).

As to claim 14, Manning discloses further comprising displaying the match list (See column 5, lines 22-26).

As to claim 16, Manning discloses comprising displaying a new match list including any numbers matching the sequence of entered digits and wildcards from a previous match list (See column 3, lines 18-23).

As to claim 17, Manning discloses comprising receiving additional entries until a predetermined number of digits and wildcards are entered (See column 6, lines 39-63).

As to claim 18, Manning discloses comprising ending the method in response to the occurrence of one of:

receiving a predetermined signal;

failing to match any numbers in the match list; and
receiving a predetermined number of digits and wildcards (See column 6, lines 39-63).

As to claim 19, Manning discloses wherein receiving the predetermined signal comprises **one of:**

selecting a number from the match list; and
receiving a clear or end signal (See column 8, lines 49-55).

As to claim 20, Manning discloses a device including a search-by-number feature, comprising:

a processor to search any stored numbers in response to receiving the at least one digit **or** a sequence of digits and wildcards and to form a match list in response to any stored numbers matching the at least one digit **or** sequence of digits and wildcards (See column 5, lines 12-40);

means for receiving an additional entry (See column 8, lines 1-15);

means for repeating receiving an additional entry until a digit is received (See column 8, lines 1-15);

means for searching the match list for numbers matching a sequence of entered digits and wildcards (See column 7, lines 6-13).

As to claim 21, Manning discloses comprising a display to display the match list (See column 5, lines 22-26).

As to claim 25, Manning discloses a computer-readable medium having computer-executable instructions for performing a method, comprising:

receiving at least one digit or a sequence of digits and wildcards (See column 5, lines 12-40); and

searching any numbers stored in a device to form a match list including any stored numbers matching the at least one digit or the sequence of digits and wildcards;

receiving any additional entries (See column 8, lines 1-15);

repeating receiving any additional entries until a digit is received (See column 8, lines 1-15); and

searching the match list for numbers matching a sequence of entered digits and wildcards (See column 6, lines 39-63, also see column 7, lines 6-13).

As to claim 26, Manning discloses comprising displaying the match list (See column 5, lines 22-26).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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8. Claims 3, 8, 11-12, and 23-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Manning (U.S. Patent No. 6,963,640 B1) in view of Haavisto et al. (U.S. Patent No. 5,864,603).

As to claims 3, and 23, Manning does not teach comprising ending the search in response **to one of:**

- no stored numbers matching the sequence of digits and wildcards;
- a displayed number being selected;
- a predetermined time period elapsing without an action by a user;
- a predetermined number of digits **or** digits and wildcards being entered; and
- a user aborting the search.

Haavisto et al. teaches comprising ending the search in response **to one of:**

- no stored numbers matching the sequence of digits and wildcards;
- a displayed number being selected;
- a predetermined time period elapsing without an action by a user (See Haavisto et al.

column 2, lines 54-57);

- a predetermined number of digits **or** digits and wildcards being entered; and
- a user aborting the search (See Haavisto et al. column 2, lines 51-54).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to having end the searching by either one of the listed methodologies since it is well known in the art a search will come to an end in many formats producing best match

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results for example by a predetermined time period elapsing without an action by a user (See Haavisto et al. column 4, lines 31-33).

As to claim 8, Manning does not teach comprising displaying only one stored number of a group of stored numbers in each match list that are variations of a same phone number.

Haavisto et al. teaches comprising displaying only one stored number of a group of stored numbers in each match list that are variations of a same phone number (See Haavisto et al. column 7, lines 40-49, also see Haavisto et al. column 8, lines 26-36).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to displaying only one stored number of a group of stored numbers in each match list that are variations of a same phone number since it is well known the numbers can be matching up to the very last digit in order to have exact match (See Haavisto et al. column 2, lines 26-32).

As to claim 11, Manning does not teach comprising entering the at least one digit or sequence of digits and wild cards by voice recognition.

Haavisto et al. teaches comprising entering the at least one digit or sequence of digits and wild cards by voice recognition (See Haavisto et al. column 2, lines 40-44, also see Haavisto et al. column 3, lines 1-5).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to entering the at least one digit or sequence of digits and wild cards by

voice recognition since it provides convenience and ease of operation while driving for example (See Haavisto et al. column 1, lines 26-43).

As to claim 12, Manning does not teach comprising selecting a search-by-number feature from a menu by voice activation.

Haavisto et al. teaches comprising selecting a search-by-number feature from a menu by voice activation (See Haavisto et al. column 3, lines 1-5).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to selecting a search-by-number feature from a menu by voice activation since it provides convenience and ease of operation while driving for example (See Haavisto et al. column 1, lines 26-43).

As to claim 24, Manning does not teach wherein the at least one data storage device comprises at least **one of**:

a call list, a missed call list and a phonebook.

Haavisto et al. teaches wherein the at least one data storage device comprises at least **one of**:

a call list, a missed call list and a phonebook (See Haavisto et al. column 7, lines 22-30, also see Haavisto et al. column 8, lines 17-23).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to wherein the at least one data storage device comprises at least **one**

of: a call list, a missed call list and a phonebook since it is well known in the art that any of those storage devices are part of the telephone set.

Allowable Subject Matter

9. Claims 4, 9-10, 22, and 27 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

10. Applicant's arguments with respect to claims 1-14, and 16-27 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure

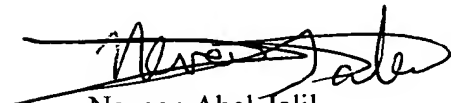
Rapaport et al. (U.S. Patent No. 6,192,112 B1) teaches voice response system.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Neveen Abel-Jalil whose telephone number is 571-272-4074.

The examiner can normally be reached on 8:30AM-5: 30PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey A. Gaffin can be reached on 571-272-4146. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Neveen Abel-Jalil
January 23, 2006